

AMENDMENTS TO THE DRAWINGS

The attached sheets of drawings include changes to FIGS. 17-21 to add the legend “Prior Art” to each of these figures.

Attachment: Replacement sheets
 Annotated sheet showing changes

REMARKS

STATUS OF CLAIMS

Claims 1-5 and 9-13 are pending. Claims 5-8 were previously cancelled without prejudice or disclaimer and claim 12 is now also canceled without prejudice or disclaimer. Claims 2 and 10 have been rewritten in independent form and claim 9 has been rewritten in essentially independent form to eliminate conflicts with parent claim 1. Care has been taken to avoid the addition of new matter.

SUMMARY OF OFFICE ACTION

The Office Action is a non-final Action that acknowledges the claim for foreign priority, the receipt of the priority document, objects to FIGS. 17-21, objects to claims 2-5 and 10 as being dependent on a rejected claim, rejects claims 11 and 12 under 35 U.S.C. §103(a) as being allegedly unpatentable over Aiello et al. (U.S. Patent No. 7,031,294, hereinafter "Aiello '294") in view of Aiello et al. (U.S. Patent No. 6,952,456, hereinafter "Aiello '456"), and rejects claims 1, 9, and 13 under 35 U.S.C. §103(a) as being allegedly unpatentable over Aiello '294 in view of Aiello '456 and further in view of what is characterized in the outstanding Action as "what is disclosed as prior art in Figs. 17-21 and page 1 line 14 to page 6 line 13 of the applicant's specification." The outstanding Action fails to acknowledge the references cited by the IDS filed on January 25, 2006.

IDS NOT ACKNOWLEDGED

The IDS filed on January 25, 2006, is believed to be fully compliant with the rules of the USPTO. Thus, acknowledgement of consideration of the references cited by this IDS is respectfully requested.

CLAIM OBJECTIONS

Claims 2-5 and 10 were objected to as being dependent on a rejected claim and indicated to be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claim. As claim 2 and claim 10 have been rewritten in independent form to

include all of the limitations of base claim 1, and as there are no intervening claims, the allowance of claims 2 and 10 is respectfully requested.

In addition, as claims 3-5 all directly depend from claim 2 that should now be considered allowable, it is respectfully submitted that claims 3-5 should also be considered to be allowable.

DRAWING OBJECTIONS

FIGS. 17-21 were objected to as showing only that which is old and were required to be designated by a legend such as "Prior Art." As the included replacement sheets of Drawings containing new Figs. 17-21 are so labeled, withdrawal of this objection is respectfully requested.

REJECTION OF CLAIMS 11 AND 12 UNDER 35 U.S.C. §103

Item #4 at the bottom of page 3 of the outstanding Action presents the above-noted rejection of claims 11 and 12 under 35 U.S.C. §103(a) as being allegedly unpatentable over Aiello '294 in view of Aiello '456. This rejection of claim 12 is considered to be moot in view of the cancellation thereof and the rejection of claim 11 on this ground is traversed.

Claim 11 specifies, *inter alia*, the following:

...
a beacon detection signal output unit outputting to said access control unit, when data that is a beacon is received by said reception unit, a beacon detection signal with higher priority given thereto over said transmission data, without queuing said beacon detection signal together with said transmission data in said interface ...

The outstanding Action fails to address this limitation of claim 11 at pages 5-6 thereof that concentrated exclusively on limitations that either appear only in cancelled claim 12 or that appear in both cancelled claim 12 and claim 11. As not all the limitations of claim 11 have been even alleged to be taught by Aiello '294 in view of over Aiello '456, the outstanding Action fails to establish a *prima facie* case of obviousness as to claim 11 subject matter and the rejection of claim 11 under 35 U.S.C. §103(a) as being allegedly unpatentable over Aiello '294 in view of over Aiello '456 should, accordingly, be withdrawn.

REJECTION OF CLAIMS 1, 9, and 13 UNDER 35 U.S.C. §103

Item #2 on page 6 of the outstanding Action sets forth the above-noted a rejection of claims 1, 9, and 13 under 35 U.S.C. §103(a) as being allegedly unpatentable over Aiello '294 in view of Aiello '456 and further in view of what is characterized in the outstanding Action as "what is disclosed as prior art in Figs. 17-21 and page 1 line 14 to page 6 line 13 of the applicant's specification." This rejection is traversed.

Claim 1 specifies, *inter alia*, the following:

...

said beacon detection signal output unit outputs, from said MAC layer to said LINK layer, a beacon detection signal with higher priority given thereto over said transmission data, without queuing said beacon detection signal together with said transmission data in said interface ...

Page 7 of the outstanding Action appears to suggest that Aiello '294 is being relied upon as teaching this limitation, or at least the part thereof requiring the "beacon detection signal being given higher priority over said transmission data" at col. 1, lines 56-61 that "recite the use of priority." This reliance is clearly improper because the "priority" mentioned at col. 1, lines 56-61 of Aiello '294 has nothing to do with any "beacon detection signal" and has no relationship to there being no "queuing" of the "beacon detection signal together with said transmission data in said interface." The only thing taught at col. 1, lines 56-61 of Aiello '294 is giving "isochronous data" of isochronous transfers apparent priority over asynchronous ones as follows:

Firewire, or IEEE 1394, is an emerging wireline network technology that is essentially asynchronous, but provides for isochronous transfers or "sub-actions". Isochronous data is given priority, but consistent time intervals of data transfer is limited by mixing isochronous and purely asynchronous transfers.

The word "priority" cannot be taken out of this reference context and turned into a totally unrelated teaching by the PTO. In this last regard, *In re Kotzab* 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) notes that "[reference] statements cannot be viewed in the abstract. Rather they must be considered in the context of the teaching of the entire reference." This is not new law, note *In re Wesslau*, 147 USPQ 391, 393 (CCPA 1965) stating that "it is

impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art."

As independent claim 13 includes a similar limitation and as there is no relevant teaching or suggestion of these limitations to be found in Aiello '294, Aiello '456, or in what is characterized in the outstanding Action as "what is disclosed as prior art in Figs. 17-21 and page 1 line 14 to page 6 line 13 of the applicant's specification," there is no presentation of a valid case of *prima facie* obviousness and this rejection should also be withdrawn as to independent claims 1 and 13.

Furthermore, as rewritten independent claim 9 includes a similar limitation, there is further no case of *prima facie* obviousness established as to claim 9 subject matter, and the rejection of claim 9 under 35 U.S.C. §103(a) as being allegedly unpatentable over Aiello '294 in view of Aiello '456 and further in view of what is characterized in the outstanding Action as "what is disclosed as prior art in Figs. 17-21 and page 1 line 14 to page 6 line 13 of the applicant's specification" is also clearly improper and should be withdrawn.

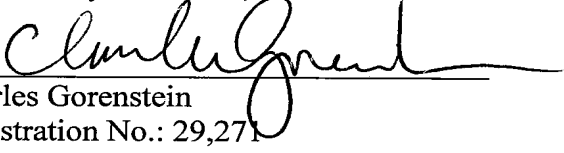
CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Jr., Reg. No. 40,440 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: June 10, 2009

Respectfully submitted,

By 
Charles Gorenstein
Registration No.: 29,271

BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant